

Patent
Attorney Docket No.: AUS920030753US1
(IBM-0034)

REMARKS

Claims 1-12 and 18-39 are pending in this application.

Claims 1, 2, 6-12, 18, 19, 23-25, 30, 31, 35-39 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Koster (US 6,253,081) in view of Mazzarella (US 6,819,921).

Koster teaches a method for providing roaming services in a telecommunications system that is only partially enabled for local number portability (LNP). (Koster, Title). After a roaming cellular mobile radiotelephone (CMR) transmits a registration request containing its mobile identification number (MIN) to a host mobile switching center (MSC), the host MSC sends a registration notification message to the CMR's home location register (HLR). (Koster, Abstract, lines 4-13). The CMR's HLR returns a validation response message to the host MSC to authorize automatic roaming service, restricted roaming service, or no service.

In every embodiment disclosed by Koster, the host MSC sends a registration notification message to the CMR's HLR and then receives a validation response message back from the CMR's HLR. These communications do not involve the CMR itself or the user of the CMR. In fact, the only communication required of the CMR is the initial transmission of a registration request. This communication is shown as step 302 of Figure 1. Furthermore, Koster does not teach that there would be even a return communication from the host MSC to the CMR, but rather the host MSC communicates directly with the CMR's HLR and then either provides or does not provide roaming service of one level or another.

Accordingly, Koster fails to teach, show or suggest any aspect of a special roaming contract between a roaming network and a wireless telephone. Rather, Koster teaches away from a special roaming contract by disclosing that whether or not to provide roaming services to a wireless telephone should be determined by communications between the host MSC and the CMR's HLR.

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The invention of claim 1 includes, among other things, the limitations of:

offering a *special roaming contract* to a user of the wireless telephone;
providing the *special roaming contract* to the user;
storing the identity and terms of the *special roaming contract* within the
roaming network; and
providing roaming service for the wireless telephone pursuant to the *special
roaming contract*.

While the examiner has briefly asserted that all these limitations are disclosed by Koster, the only citation of support is a general reference to Figures 3 and 5 of Koster. The rejection did not state how these Figures make such a disclosure.

Figure 3 details a CMR registration routine 300 and Figure 5 details registration of a CMR for restricted roaming service. Neither of these methods, alone or in combination, describes a communication that offers or establishes a special roaming contract between a roaming network and a wireless telephone user. Whereas Koster's methods are directed at establishing roaming service under existing agreements, the methods of establishing whether roaming services will be provided do not involve communications with the wireless telephone beyond the initial registration request of step 302. Accordingly, there is nothing in Koster that would suggest offering a special roaming contract to a user of the wireless telephone or, for that matter, any other step involving a special roaming contract.

Mazzarella et al. has been asserted as teaching a request including an electronic serial number (ESN). (Office Action, page 3; *citing* Mazzarella et al., col. 3, lines 42-56). However, the cited passage of Mazzarella only teaches the optional inclusion of the ESN in a *porting request* sent from a new service provider 30 to an old service provider 20. (Mazzarella, col. 3, lines 42-56). A *porting request* is made when a wireless telephone subscriber is canceling his subscription with a first wireless service provider and signing up with a second wireless service provider. Mazzarella teaches that rather than requiring the subscriber to surrender the mobile directory number (MDN) assigned to its mobile station by the old wireless service provider and be assigned a new MDN by the new

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wireless service provider, it is possible to "port" or take the MDN from one wireless service provider to another. (Mazzarella, col. 1, lines 20-28). This *porting request* is not part of a roaming process, but part of changing the user's account to a new service provider. Mazarella does not teach or suggest that a *request for roaming service*, received by a roaming network from a wireless telephone, should comprise a mobile identification number and an electronic serial number. Therefore, Applicant asserts that Mazzarella does not support the assertions for which it was cited and does not make up for deficiencies of the Koster disclosure as detailed herein. Accordingly, a *prima facie* case of obviousness has not been established. Applicant respectfully requests reconsideration and withdrawal of the rejection.

Regarding claims 7-12, the examiner has stated that the combination of Koster and Mazzarella fails to teach that an offer for the special roaming contract is provided over a telephone, etc. Then, the examiner takes Official Notice that these limitations are known in the art. (Office Action, page 4, lines 7-8). However, the Applicant reasserts that the primary and secondary references do not teach or suggest a special roaming contract between a wireless telephone user and a roaming network. In order to establish a *prima facie* case of obviousness, the examiner must point out evidence of such a special roaming contract. Reconsideration and withdrawal of the rejection is requested.

Claims 3-5, 20-22, 32-34 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Applicant thanks the examiner for indicating that the allowable subject matter includes issuing a contract code to the user, wherein the contract code identifies the special roaming contract. Applicant believes that in view of the foregoing explanations of the reference, the examiner will now find all the pending claims to be allowable.

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In the event there are additional charges in connection with the filing of this Response, the Commissioner is hereby authorized to charge the Deposit Account No. 50-0714/IBM-0034 of the firm of the below-signed attorney in the amount of any necessary fee.

Respectfully submitted,



Jeffrey L. Streets
Attorney for Applicant
Registration No. 37,453
STREETS & STEELE
13831 Northwest Freeway, Suite 355
Houston, Texas 77040
(713)939-9444